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### REMARKS

Claims 1-96 are pending in the present application. In the Office Action, the Examiner has stated that Applicant is required to elect an invention for prosecution between a first set of claims drawn to a method of making an interior rearview mirror assembly (Group I) and a second set of claims drawn to an interior rearview mirror assembly. In addition to the restriction outlined above, the Examiner has stated that each group includes 13 restrictable sets of claims. According to the Examiner, Group I includes the following subgroups:

- a. Claims 2-4, 22-24, 61-63, drawn to a method of making an interior rearview mirror assembly with thickness specifics;
- b. Claims 5, 25, 42, drawn to a method of making an interior rearview mirror assembly with plate frame specifics;
- c. Claims 6, 26, 60 drawn to a method of making an interior rearview mirror assembly with pivot ball specifics;
- d. Claims 7, 8, 27, 28, 45, 46, drawn to a method of making an interior rearview mirror assembly with cover specifics;
- e. Claims 9, 10, 29, 30, 43, 44, 47, 48, drawn to a method of making an interior rearview mirror assembly with integral pivot ball and plate frame specifics;
- f. Claims 11, 12, 31, 32, 49, 50, drawn to a method of making an interior rearview mirror assembly with integral pivot ball, stem, plate frame specifics;
- g. Claims 13, 14, 33, 34, 52, 53, drawn to a method of making an interior rearview mirror assembly with bezel specifics;
- h. Claims 15, 16, 35, 36, drawn to a method of making an interior rearview mirror assembly with integral pivot ball and mount specifics;
- i. Claims 17, 37, 56, drawn to a method of making an interior rearview mirror assembly with circuit board specifics;
- j. Claims 19, 20, 39, 40, drawn to a method of making an interior rearview mirror assembly with sleeve specifics;

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- k. Claims 54, 55 drawn to a method of making an interior rearview mirror assembly with integral pivot ball, mount and cover specifics;
- l. Claims 58, 59, drawn to a method of making an interior rearview mirror assembly with 1<sup>st</sup> and 2<sup>nd</sup> pivot ball specifics; and
- m. Claims 18, 38, 57, drawn to a method of making an interior rearview mirror assembly with spacing of pivot ball and plate frame specifics.

Furthermore, according to the Office Action, Group II includes the following subgroups:

- a. Claims 65, 84, 85, drawn to an interior rearview mirror assembly with plate frame and pivot ball specifics;
- b. Claim 66, drawn to an interior rearview mirror assembly with pivot ball specifics;
- c. Claims 67, 68, 90, 91 drawn to an interior rearview mirror assembly with mount and pivot ball specifics;
- d. Claims 69-73, drawn to an interior rearview mirror assembly with cover specifics;
- e. Claims 75, 76, drawn to an interior rearview mirror assembly with stem and pivot ball specifics;
- f. Claim 77, drawn to an interior rearview mirror assembly with stem specifics;
- g. Claim 79, drawn to an interior rearview mirror assembly with pivot ball, plate frame and mount specifics;
- h. Claims 80, 81, 82 drawn to an interior rearview mirror assembly with plate frame and cover specifics;
- i. Claim 83, drawn to an interior rearview mirror assembly with mount and plate frame specifics;
- j. Claim 86, 87 drawn to an interior rearview mirror assembly with pivot ball, stem and plate frame specifics;
- k. Claims 88, 89, drawn to an interior rearview mirror assembly with bezel specifics;
- l. Claim 92, drawn to an interior rearview mirror assembly with spacing of pivot ball and plate frame specifics; and

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- m. Claims 93-95, drawn to an interior rearview mirror assembly with first and second pivot ball specifics.

Applicant elects Group I, subgroup a of the claims with traverse. According to the Office Action, Group I, subgroup a is drawn to a method of making an interior rearview mirror assembly with thickness specifics and includes claims 1-4, 21-24, 41, 51 and 61-63. Furthermore, as discussed below, all pending claims should be examined.

First, Applicants submit that the restriction between Group I and Group II as set forth in the Office Action is improper. In our opinion, the Office Action is not well taken. The Examiner has made a first restriction between Group I, drawn to a method of making an interior rearview mirror assembly including claims 1-63 and Group II, drawn to an interior rearview mirror assembly including claims 64-96. According to the Examiner, the inventions of Groups I and II are related as a process of making and a product made. The Examiner goes on to state that the assembly of Group II can be made by injection molding, and that such process is a different process than that of the method of claims 1-63. However, claim 41 states that providing the interior rearview mirror components includes forming at least one of the components from a material comprising magnesium. The term "forming" includes injection molding. Accordingly, this is not a different process than the method claimed in claim 41. The Examiner has sidestepped this issue by making the dubious statement in the Office Action that claim 51 is not considered to be patentably distinct from claim 41. Claim 51 states that forming at least one of the components from a material comprising magnesium comprises thixoforming molding the at least one of the components. Therefore, the Examiner apparently is stating that "forming" in claim 41 is thixoforming. However, this is just not the case and the Examiner has only made this statement in order to justify his improper restriction. Accordingly, we do not believe that a restriction between Groups I and II is proper.

Regarding the restriction for subcombinations usable together, distinct claims each claiming subcombinations usable together that contain species under a genus (or generic) claim must have the question of restriction determined by both the practice applicable to election of species and the practice applicable to related inventions. The inventions of the subgroups a-j and m of Group I all include dependent claims that are all dependent on independent claim 1, and as

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such, the subcombinations are claimed under a common genus claim. Specifically, claim 1 is a generic claim. In other words, claim 1 reads upon all of the claims that depend from claim 1. Furthermore, the invention of subgroups a-g and i-m include dependent claims that are all dependent on independent claim 41 and as such, the subcombinations are claimed under a common genus claim. Specifically, claim 41 is a generic claim. In other words, claim 41 reads upon all of the claims that depend from claim 41. Moreover, the Examiner has indicated that all of the claims in the subgroups of Group I are claims drawn to a subcombination.

An independent claim cannot be considered a combination relative to a "subcombination" claim that depends from that independent claim. A subcombination, by definition, includes less than all of the elements of the combination. A dependent claim clearly cannot include less than all of the elements of the claim(s) on which it depends. Accordingly, for example, claim 2 (Group I, subgroup l), claim 5 (Group I, subgroup b), and claim 6 (Group I, subgroup c) are all combination claims, with claim 1 being the subcombination claim of each of these claims. Therefore, claim 1 is readable on all of its dependent claims and is therefore generic to all of the claims that depend upon claim 1. Clearly, the dependent claims in the groups include all the elements of claim 1, from which claims 2-40 depend. Therefore, claims 2-40 are all species disclosed under a claimed genus and related (and all claims 42-63 are species disclosed under a claimed genus and related). Accordingly, the requirements for election of species must also be applied. The same analysis applies to all claims in Group II. Such an analysis was not made by the Examiner.

Nevertheless, claimed elements of different groups as defined in the Office Action may be usable together. Therefore, such components are not mutually exclusive of one another. For an election of species requirement to be proper, the two claimed species must be mutually exclusive of one another and may not be used together in the combination. Because the Examiner has failed to apply the criteria for election of species and because the criteria would not apply in this instance, Applicant submits that the restriction requirement between the groups is improper.

Furthermore, claimed subcombinations must be disclosed as usable together in a single combination. "Two or more claim subcombinations, disclosed as useful together in a single

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combination, and which can be shown to be separately usable, are usually distinct from each other." M.P.E.P. §806.05(b). The subgroups set forth in the Office Action are not subcombinations that are disclosed as usable together in a single combination. As an example, claim 2 (Group I, subgroup a), claim 5 (Group I, subgroup b) and claim 6 (Group I, subgroup c) are claims that do not define subcombinations disclosed as usable together in a single combination. Claims 2, 5 and 7 are all dependent claims. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference and to the dependent claim." 37 C.F.R. §1.75(c).

If claims 2, 5 and 7 each define a subcombination as stated by the Examiner, the subcombinations combined together in a single combination would include at least three plate frame covers, three mounts, three pivot balls and three mirrors. However, no such combination is disclosed in the present application. Therefore, the claims in the subcombinations of Group I are not subcombinations that should have been subject to a restriction requirement. The remaining claims made subject to the restriction requirement can be analyzed as discussed above.

Upon reviewing the Examiner's statements as to why the claims are restricted, it is apparent that the Examiner may be considering dependent claims as though they were independent claims. Applicant submits that the restriction requirement as presented is clearly erroneous and therefore submits that the restriction requirement regarding subcombinations usable together should be withdrawn. Therefore, the claims identified in Groups I and II and all subgroups thereof should be examined with the election of Group I. Accordingly, Applicant submits that all claims should be examined along with the election of Group I.

Applicant's election of Group I, subgroup a therefore requires the Examiner to examine claims 1-96.


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All pending claims 1-96 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

Date

11/23/05

  
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